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November 29, 2004

CERTIFICATE OF MAILING 37 C.F.R. 1.8

I certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date below:

November 29, 2004

Date

Robert E. Hanson

MS AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

RE: *U.S. Patent Application No. 10/618,101 entitled "HIGH YIELDING SOYBEAN PLANTS WITH INCREASED SEED PROTEIN PLUS OIL" – Joseph R. Byrum et al.*
Our reference: MSUT:008US
Client reference: MON-53106
Renessen Ref No.: REN-02-099


Sir:

Enclosed for filing in the above-referenced patent application is an Information Disclosure Statement, Form PTO-1449, and references A1-A10 and C1-C49.

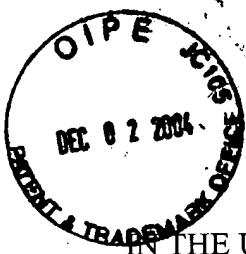
No fees are believed to be due in connection with the filing of this Information Disclosure Statement, however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be deemed necessary for any reason relating to the enclosed materials, the Commissioner is authorized to deduct the appropriate fees from Fulbright & Jaworski Deposit Account No.: 50-1212/MSUT:008US.

Please date stamp and return the enclosed postcard evidencing receipt of these materials.

Respectfully submitted,


Robert E. Hanson
Reg. No. 42,628

REH/kmv
Encl.: as noted



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Joseph R. Byrum et al.

Serial No.: 10/618,101

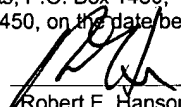
Filed: July 11, 2003

For: HIGH YIELDING SOYBEAN PLANTS
WITH INCREASED SEED PROTEIN
PLUS OIL

Group Art Unit: 1638

Examiner: Unknown

Atty. Dkt. No.: MSUT:008US

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| Date | Robert E. Hanson |

INFORMATION DISCLOSURE STATEMENT

MS AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In compliance with the duty of disclosure under 37 C.F.R. § 1.56, it is respectfully requested that this Information Disclosure Statement be entered and the documents listed on attached Form PTO-1449 be considered by the Examiner and made of record. Copies of the listed documents required by 37 C.F.R. § 1.98(a)(2) are enclosed for the convenience of the Examiner.

In accordance with 37 C.F.R §§ 1.97(g), (h), this Information Disclosure Statement is not to be construed as a representation that a search has been made, and is not to be construed to be

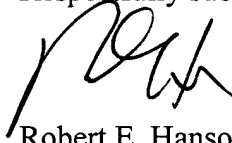
an admission that the information cited is, or is considered to be, material to patentability as defined in 37 C.F.R. § 1.56(b).

The present Information Disclosure Statement is being filed prior to the receipt of a first Official Action reflecting an examination on the merits, and hence is believed to be timely filed in accordance with 37 C.F.R § 1.97(b). No fees are believed to be due in connection with the filing of this Information Disclosure Statement, however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be deemed necessary for any reason relating to these materials, the Commissioner is authorized to deduct the appropriate fees from Fulbright & Jaworski Deposit Account No.: 50-1212/MSUT:008US.

This application is related by inventorship and subject matter to co-pending U.S. application numbers 10/618,098, filed July 11, 2003, 10/194,992 filed July 11, 2003, 10/194,453 filed July 11, 2002 and 10/618,103 filed July 11, 2003.

Applicants respectfully request that the listed documents be made of record in the present case.

Respectfully submitted,



Robert E. Hanson
Reg. No. 42,628
Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.
600 Congress Avenue, Suite 2400
Austin, Texas 78701
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Date: November 29, 2004

Form PTO-1449 (modified)

Atty. Docket No.

MSUT:008US

Serial No.

10/618,101

List of Patents and Publications for Applicant's

Applicant

Joseph R. Byrum *et al.*

INFORMATION DISCLOSURE STATEMENT

(Use several sheets if necessary)

Filing Date:

July 11, 2003

Group:

1638

U.S. Patent Documents

See Page 1

Foreign Patent Documents

See Page 1

Other Art

See Page 1

U.S. Patent Documents

| Exam. Init. | Ref. Des. | Document Number | Date | Name | Class | Sub Class | Filing Date of App. |
|-------------|-----------|-----------------|----------|------------------------|-------|-----------|---------------------|
| | A1 | 5,084,082 | 01/28/92 | Sebastian | 71 | 90 | 02/20/90 |
| | A2 | 5,304,728 | 04/19/94 | Eby | 800 | 200 | 06/01/93 |
| | A3 | 5,523,520 | 6/04/96 | Hunsperger and Holtrop | 800 | 200 | 6/24/94 |
| | A4 | 5,569,815 | 10/29/96 | Eby | 800 | 200 | 01/17/95 |
| | A5 | 5,576,474 | 11/19/96 | Lussenden | 800 | 200 | 10/06/95 |
| | A6 | 5,576,475 | 11/19/96 | Matson | 800 | 200 | 10/06/95 |
| | A7 | 5,650,552 | 7/22/97 | Matson | 800 | 200 | 5/17/96 |
| | A8 | 5,723,741 | 3/03/98 | Matson and Lewis | 800 | 200 | 2/12/97 |
| | A9 | 6,140,556 | 10/31/00 | Conway | 800 | 312 | 1/15/99 |
| | A10 | 6,313,380 | 11/06/01 | Moots | 800 | 312 | 1/06/00 |

Foreign Patent Documents

| Exam. Init. | Ref. Des. | Document Number | Date | Country | Class | Sub Class | Translation Yes/No |
|-------------|-----------|-----------------|------|---------|-------|-----------|--------------------|
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Other Art (Including Author, Title, Date Pertinent Pages, Etc.)

| Exam. Init. | Ref. Des. | Citation |
|-------------|-----------|--|
| | C1 | Allard, University of California, Davis, California, "Selection under self-fertilization," <i>Principles of Plant Breeding</i> , Published by John Wiley & Sons, New York, University of California, Davis, California, 50-98, 1960. |
| | C2 | Bernard, ed., "Evaluation of Maturity Groups I and II of the U.S.D.A. Soybean Collection," pp. 1-3, 58-59, September 1966. |
| | C3 | Bernard, ed., "Evaluation of Maturity Groups III and IV of the U.S.D.A. Soybean Collection," pp. 1-3, 5a-5d, 8a-8d, 9a-9d, 14a-14d, 17a-17d, 24a-24d, and 25a-25d, April 1969. |

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|---|---|--|--------------------------|
| Form PTO-1449 (modified) | | Atty. Docket No. MSUT:008US | Serial No. 10/618,101 |
| List of Patents and Publications for Applicant's INFORMATION DISCLOSURE STATEMENT (Use several sheets if necessary) | | Applicant Joseph R. Byrum <i>et al.</i> | |
| | | Filing Date: July 11, 2003 | Group: 1638 |
| U.S. Patent Documents <i>See Page 1</i> | Foreign Patent Documents <i>See Page 1</i> | Other Art <i>See Page 1</i> | |

Other Art (Including Author, Title, Date Pertinent Pages, Etc.)

| Exam. Init. | Ref. Des. | Citation |
|-------------|-----------|---|
| | C4 | Brim and Burton, "Recurrent selection in soybeans. II. Selection for increased percent protein in seeds," <i>Crop Science</i> , 19:494-498, 1979. |
| | C5 | Burton, J.W. 1985. Breeding soybeans for improved protein quantity and quality. P. 361-367. In R. Shibles (ed.) <i>Proc. 3rd World Soybean Res. Conf.</i> , Ames, IA. 12-17, Westview Press, Boulder, CO, 1984. |
| | C6 | Burton, J. W. and Brim, C. A., "Recurrent selection in soybeans. III Selection for increased percent oil in seeds," <i>Crop Sci.</i> , 81: 31-34, 1981. |
| | C7 | Byth <i>et al.</i> , "Correlated truncation selection for yield in soybeans," <i>Crop Sci.</i> , 9:699-702, 1969. |
| | C8 | Caldwell <i>et al.</i> , "Selection value of phenotypic attributes in soybeans," <i>Crop Sci.</i> , 6:249-251, 1966. |
| | C9 | Ciansio and Fehr, "Genetic variability for soybean seed composition in crosses between high and low protein parents," <i>J. Agric. Univ. PR</i> , 66:123-129, 1982. |
| | C10 | Eshed <i>et al.</i> , "Less-than-additive epistatic interactions of quantitative trait loci in tomato," <i>Genetics</i> , 143:1807-1817, 1996. |
| | C11 | Fehr, "In: Soybeans: Improvement, Production and Uses," 2nd Edition, <i>Monograph</i> 16, p. 249 and 259, 1987. |
| | C12 | Fehr, Iowa State University. "Principles of Cultivar Development," vol. 1 Theory and Technique and vol. 2 Crop Species, Soybean, Published by Macmillan Publishing Company, New York, P. 360-376, 1987. |
| | C13 | Fulmer, "The soybean as a chemical factory," In: <i>Soybean Utilization Alternatives</i> , McCann (ed.), The Center for Alternative Crops and Products, Univ. of Minnesota, 1-12, 1988. |
| | C14 | GRIN Database Entry PI438065 (9 Aug. 1994), From The Internet http://www.ars-grin.gov . |
| | C15 | GRIN Database Entry PI540555 (1988), From The Internet http://www.ars-grin.gov . |
| | C16 | Hanson <i>et al.</i> , "Genetic analysis of energy production in the soybean," <i>Crop Science</i> , 121-126. |
| | C17 | Hartwig, E. E., "Breeding productive soybeans with a higher percentage of protein," In: <i>Seed Protein improvement in cereals and legumes</i> , Vol. II, Intl. Atomic Energy Agency, Vienna, 59-66, 1979. |

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Other Art (Including Author, Title, Date Pertinent Pages, Etc.)

| Exam. Init. | Ref. Des. | Citation |
|-------------|-----------|--|
| | C18 | Hartwig, "Breeding soybeans for high protein content and quality," In <i>New approaches to breeding for improved plant protein</i> , International Atomic Energy Agency, Vienna, 1969. |
| | C19 | Hartwig, E. E., "Varietal improvement," In: <i>Soybeans: Improvement, production, and uses</i> , Caldwell (ed.), 1 st edition, Agronomy, 16:187-210, 1969. |
| | C20 | Hartwig and Hinson, "Association between chemical composition of seed and seed yield of soybeans," <i>Crop Sci.</i> , 22:829-830, 1972. |
| | C21 | Hymowitz, "Soybeans," In: <i>Evolution in crop plants</i> , Simmonds (ed.), Longman Group, London, 159-162, 1976. |
| | C22 | Johnson, H. W., "Breeding for oil and protein in soybeans," <i>Soybean Digest</i> , 21(11):73-75, 1961. |
| | C23 | Kraft <i>et al.</i> , "Linkage disequilibrium and fingerprinting in sugar beet," <i>Theor. Appl. Genet.</i> , 101:323-326, 2000. |
| | C24 | Kwon and Torrie, "Heritability of and interrelationships among traits of two soybean populations," <i>Crop Sci.</i> , 4:196-198, 1964. |
| | C25 | Leffel and Rhodes, "Agronomic performance and economic value of high-seed protein soybean," <i>J. Prod. Agric.</i> , 6:365-368, 1993. |
| | C26 | Leffel, R. C., "High protein lines and chemical constituent pricing in soybean," <i>J. Prod. Agric.</i> , 1:111-115, 1988. |
| | C27 | Mounts <i>et al.</i> , "Processing and utilization," In: <i>Soybeans: Improvement, Production and Uses</i> , Wilcox (ed.), <i>Am. Soc. Agron.</i> , Madison, WI, 1987. |
| | C28 | Nickell and Bernard, "Registration of L84-5873 and L84-5932 Soybean Germplasm Lines Resistant to Brown Stem Rot," <i>Crop Sci.</i> , 32:835, 1992. |
| | C29 | Nickell <i>et al.</i> , "Registration of 'Hamilton' soybean," <i>Crop Sci.</i> , 30:1364, 1990. |
| | C30 | Openshaw and Hadley, "Selection indices to modify protein concentration of soybean seeds," <i>Crop Sci.</i> , 24:1-4, 1984. |
| | C31 | Orf, "Modifying soybean composition by plant breeding," In: <i>Soybean utilization alternative</i> , Univ. Minnesota Center Alternative Crops and Products, McCann (ed.), St. Paul, 131-141, 1988. |

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| Exam. Init. | Ref. Des. | Citation |
|-------------|-----------|--|
| | C32 | Pantalone <i>et al.</i> , "Soybean fibrous root heritability and genotypic correlations with agronomic and seed quality characteristics," <i>Crop Sci.</i> , 36:1120-1125, 1996. |
| | C33 | Plant Variety Protection Certification Application 9000006. |
| | C34 | Sebern and Lambert, "Effect of stratification for percent protein in two soybean populations," <i>Crop Sci.</i> , 24:225-228, 1984. |
| | C35 | Serretti <i>et al.</i> , "Amino acid profiles of high seed protein soybean," <i>Crop Sci.</i> , 34:207-209, 1994. |
| | C36 | Shannon <i>et al.</i> , "Estimated gains from selection for protein and yield in the F4 generation of six soybean populations," <i>Crop Sci.</i> , 12:824-826, 1972. |
| | C37 | Shorter <i>et al.</i> , "Estimates of selection parameters associated with protein and oil content of soybean seeds (<i>Glycine max</i> (L.) Merr.)," <i>Aust. J. Agric. Res.</i> , 28:211-222, 1976. |
| | C38 | Simpson and Wilcox, "Genetic and phenotypic associations of agronomic characteristics in four high protein soybean populations," <i>Crop Sci.</i> , 23:1077-1081, 1983. |
| | C39 | Sneep and Hendriksen, eds., "Plant Breeding Perspectives," Wageningen: Centre for Agricultural Publishing and Documentation, 1979. |
| | C40 | Thorne and Fehr, "Incorporation of high protein, exotic germplasm into soybean populations by 2- and 3-way crosses," <i>Crop Sci.</i> , 10:652-655, 1970. |
| | C41 | Wehrmann <i>et al.</i> , "Transfer of high seed protein to high-yielding soybean cultivars," <i>Crop Sci.</i> , 27:927-931, 1987. |
| | C42 | Wilcox and Cavins, "Backcrossing high seed protein to a soybean cultivar," <i>Crop Sci.</i> , 35:1036-1041, 1995. |
| | C43 | Wilcox, C1944 and C1945 Soybean Germplasm, <i>Crop Sci.</i> , 38(3):900, 1998. |
| | C44 | Wilcox, C1944, Accession No. PI 599584, USDA, ARS, National Genetic Resources Program, Germplasm Resources Information Network(GRIN), 1998. |
| | C45 | Wilcox, SN30017, Accession No. PI 599585, USDA, ARS, National Genetic Resources Program, Germplasm Resources Information Network(GRIN), 1998. |
| | C46 | Co-pending U.S. Patent Application No. 10/618,098 filed July 11, 2003. |
| | C47 | Co-pending U.S. Patent Application No. 10/194,992 filed July 11, 2003. |

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| Exam. Init. | Ref. Des. | Citation |
|----------------|--------------|--|
| | C48 | Co-pending U.S. Patent Application No. 10/618,103 filed July 11, 2003 |
| | C49 | Co-pending U.S. Patent Application No. 10/194,453 filed July 11, 2002. |

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